

### REMARKS

The Examiner is thanked for the thorough examination of the present application, the allowance of claims 1-10, and the indication that claims 12-14 and 16-18 contain allowable subject matter.

Only claims 11 and 15 were rejected, and they were rejected under 35 U.S.C 103(a) as allegedly unpatentable over Toyoda et al (U.S. 6,594,490) in view of Cropper (U.S. Patent No. 5,819,178). Applicant has amended claims 11 and 15 to incorporate the subject matter of claims 13 and 17, respectively. Claims 13 and 17 have been, correspondingly, canceled.

Specifically, claims 11 and 15 have been amended to add the feature of: "the location information table comprises a location code field, an LAI field, and an MSC address field." This feature is neither disclosed nor suggested in the cited art of record. Therefore, the addition of this feature to claims 11 and 15 serves to patently define these claims over the cited art.

As a separate and independent basis for the patentability of claims 11 and 15, Applicant respectfully traverses the rejections as failing to identify a proper basis for combining the cited references. In combining Toyoda and Cropper, the Office Action stated only that the combination would have been obvious "to eliminate subscriber data no longer being served and to make room for the visiting subscriber data." (Office Action, p. 3). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a system for handling mobile database overflow, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in

whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000). The mere allegation, as in the present Office Action, that the combination would result in a lower manufacturing cost (or that it is “easy to delete”), is clearly insufficient to properly support the rejection (under the established Federal Circuit precedent).

For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, those rejections should be withdrawn.

#### **CitedArt**

The cited art made of record, but not relied upon, has been considered but is not believed to impact the patentability of the pending claims.

**Conclusion**

For at least the foregoing reasons, all pending claims are believed to be in condition for allowance. If the Examiner believes that a teleconference would expedite the examination of the present application, then the Examiner is invited to contact the undersigned attorney.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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